

REMARKS

Upon entry of the present amendment, claims 1-15 will be pending in the application.

Claims 1-14 have been amended to correct certain typographical errors, and for proper antecedent basis. No new matter has been introduced by these amendments.

No claims have been canceled, or added.

Reconsideration is respectfully requested in view of the following remarks.

1. **Rejection of claims 1-15 under 35 U.S.C. §103(a) as allegedly unpatentable over United States Patent No. 6,284,037 to Sapper, hereafter "Sapper", in view of CA 2,154,818 to Bergfried et al., hereafter "Bergfried".**

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Applicants respectfully submit that the present claims are patentable over the combination of Sapper and Bergfried, at least because such combination does not meet the above standard.

With respect to the grinding resins, Applicants respectfully maintain that Sapper teaches the use of grinding resins whereas independent claim 1 requires that the paste is free of grinding resins. Therefore, Sapper teaches a composition that, among other things, contains a grinding resin. On the other hand, Applicants' independent claim 1 recites an aqueous pigment paste free from binders and grinding resins. For at least this reason, Sapper does not obviate the present claims, but in fact teaches away from the same.

In response to arguments, the Examiner asserts that "Sapper teaches an acrylate polymer which is used to adjust viscosity and stabilize coating formulations (col. 1, lines 53-54). While such polymers may be used as grinding aids as shown by other references as cited by applicant, such is not explicitly taught by Sapper. In fact Sapper makes no reference to grinding the composition and it has not been shown why one of ordinary skill would want to grind the composition." (4/28/2008 Office Action, page 3, first full paragraph).

Applicants appreciate the detailed basis for rejection but must respectfully disagree. It is respectfully submitted that there is no requirement in the art that a "grinding resin" requires "grinding", as is assumed by the Examiner. Applicants disclose, for example, that "grinding resins are used for dispersing pigments", or that "they are binders whose capacity for dispersing pigments is particularly high". (Application as filed, page 7, line 24, to page 8, line 3). Therefore it is respectfully asserted that a grinding resin is a resin that can be used for **stabilizing** a pigment dispersion.

This is further affirmed by the prior art relied upon by Applicants in a previous amendment, i.e., United States Patents No. 6,476,170 and 6,630,211 to Roth and Baumgart, respectively. Roth, for examples, discloses that "[i]n use, the [grinding] resins are suspended in water to form a solution and made into a dispersion, known as a latex, by neutralizing them with a base [...]". (Roth, column 1, lines 24-27). Nowhere does Roth require any "grinding". Similar to Roth, Baumgart does not require any "grinding".

Referring back to Sapper, it is disclosed that the polymer dispersions are outstandingly suitable as "stabilizer for coating formulations". (Sapper, column 1, line 55). Therefore, Applicants respectfully assert that Sapper's grinding resin is equivalent to that of Roth and Baumgart in terms of its use, i.e., to stabilize a dispersion, among others.

Therefore, Applicants respectfully assert that Sapper does indeed teach a grinding resin, the exclusion of which is required in independent claim 1. For at least this reason, Sapper does not teach or suggest all the elements of independent claim 1, and in fact teaches away from Applicants' claims. In this regard, it is held that "[a] *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention." *In re Geisler*, 116 F.3d 1465, 1471, 43

USPQ2d 1362, 1366 (Fed. Cir. 1997). For at least this reason, Applicants further respectfully assert that Sapper cannot be used as a prior art reference because it teaches away from the present independent claim 1. These deficiencies are not and cannot be remedied by Bergfried.

Applicants further respectfully maintain that the amount of from 15 to 40% by weight of at least one metal pigment as recited in independent claim 1 is indeed unobvious over the cited prior art. There is no teaching or suggestion in the cited prior art to use 15 to 40% by weight of at least one metal pigment.

In response to arguments, the Examiner takes the position that "the criticality of the maximum amount is not relevant because the amount of mica rendered *prima facie* obvious is less than the amount taught by Bergfried". (4/28/2008 Office Action, page 4, first full paragraph).

Applicants respectfully submit that to find obviousness, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Applicants respectfully submit that no such reason has been identified by the Examiner as to why one with ordinary skill in the art would change Bergfried's 40 to 60% to Applicants' 15 to 40% by weight. The only reason given by the Examiner is that the criticality of the maximum amount is not relevant because it is less than the amount taught by Bergfried.

However, this reason is merely a conclusory statement and is not supported by any technical evidence or case law. Applicants respectfully assert that the 15 to 40% recited in independent claim 1 is indeed patentable over the cited prior art, and that there's no basis for the Examiner's rejection of the same. Applicants respectfully request that the Examiner submits technical evidence and/or case law to support the position that a range is *prima facie* obvious if it is less than a range cited in a prior art reference.

The Examiner further states that "the examiner only relied on the example in Sapper to teach aluminum as a suitable pigment in the composition taught by Sapper and

to teach the amounts in a final coating composition made from a pigment paste taught by Sapper and Bergfried". (4/28/2008 Office Action, page 5, first paragraph).

Applicants respectfully submit that the reference, i.e., Sapper, as a whole, does not teach or suggest what the Examiner is concluding, i.e., Applicants' pigment paste. Sapper teaches an example that is referred to by the Examiner (i.e., paint 1) that includes an aluminum pigment among a myriad of components, four of which being binders. Sapper does not teach, suggest, motivate, or even allude to an aqueous pigment paste that is free from binders and grinding resins such as the one in Applicants' independent claim 1. As a whole, or in part, Sapper does not provide any basis for arriving at Applicants' independent claim 1, and this fact is not remedied by Bergfried as discussed above.

In addition, in arriving at this construction, the Examiner equates Bergfried's electrically conductive pigment based on metal oxides to Applicants' aluminum pigment. Applicants respectfully submit that this alleged equivalency is improper because it is generally known in the art that when it comes to aqueous solution behavior and stability, an electrically conductive pigment based on metal oxides is substantially different from an aluminum pigment. The courts have held that "[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents". *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

In response to arguments, the Examiner asserts that since Sapper and Bergfried's pigments are conductive, they are thus equivalent. (4/28/2008 Office Action, page 5, second paragraph). However, since Bergfried is concerned with metal oxides, which behave substantially differently from metals, this assertion is without basis. Applicants respectfully submit that it is well known that many aspects of a compound and/or particle are critical in the ability for a compound and/or particle to disperse in a medium, such as polarity, particle size, surface charge, geometry, swellability, etc. The Examiner has not provided any basis as to why two chemically distinct species would be equivalent in dispersion behavior based on their conductivity.

Thus, Applicants respectfully maintain that the alleged equivalency of Bergfried's electrically conductive pigment based on metal oxides to Applicants' metal pigment is improper because it is generally known in the art that when it comes to aqueous solution behavior and stability, an electrically conductive pigment based on metal oxides is substantially different from a metal pigment. The courts have held that "[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents". *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

Therefore, even if the combination of Sapper and Bergfried was proper, which it is not since, as discussed above, Sapper teaches away from independent claim 1, one with ordinary skill in the art would not be motivated to arrive at Applicants' claim 1 at least because Bergfried's electrically conductive pigment based on metal oxides is substantially different from Applicants' metal pigment in terms of aqueous solution behavior, stability, and the like. The Examiner has not given any technical or factual basis to support that they are. It is respectfully requested that the Examiner submits technical evidence to support this position if the rejection is to be maintained.

In view of the above, Applicants respectfully assert that the present claims are patentable over the prior art because the combination of the cited art does not teach or suggest all the elements of the present claims, and does not provide any teaching or motivation to modify the prior art to arrive at Applicants' claims. In addition, Sapper teaches against Applicants' claims, and as such cannot be used as a reference in determining obviousness. Withdrawal of this rejection and allowance of the claims is respectfully requested.

Applicants further traverse the remaining assertions set forth in the office action, including the teachings of the various references. However, since these references fail to anticipate or render the claims obvious for at least the reasons set forth above, these assertions are moot and are therefore not specifically addressed in detail.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/

Mary E. Golota
Registration No. 36,814
Cantor Colburn LLP
(248) 524-2300

Friday, June 20, 2008

CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION
1609 Biddle Avenue
Wyandotte, MI 48192
Customer No. 26922

MEG/IK